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| 10/004,733 | 12/04/2001 | Thomas M. Kurth | URE02 P-310 | 8513 |

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EXAMINER

CAMERON, ERMA C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1762

DATE MAILED: 07/30/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,733

Applicant(s)

KURTH ET AL.

Examiner

Erma C. Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 1-37, 53-59, 63-82 and 86-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 38-52, 60-62 and 83-85 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-93 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1-37, 53-59 and 79-82, drawn to a method of coating a substrate, classified in class 427, subclass 426.
 - II. Claims 38-52, 60-62 and 83-85, drawn to a different method of coating a substrate, classified in class 427, subclass 426.
 - III. Claims 63-64 and 80, drawn to a boat hull, classified in class 114, subclass 356.
 - IV. Claims 65-66, drawn to a different boat hull, classified in class 114, subclass 356.
 - V. Claims 67-69, drawn to a building material composite, classified in class 52, subclass 309.1+.
 - VI. Claims 70-72, drawn to a different building material composite, classified in class 52, subclass 309.1+.
 - VII. Claims 73-78, drawn to a method of manufacturing carpet, classified in class 427, subclass 426.
 - VIII. Claims 86-89, drawn to a vehicle component liner composite, classified in class 296, subclass 39.2.
 - IX. Claims 90-93, drawn to a different vehicle component liner, classified in class 296, subclass 39.2.

The inventions are distinct, each from the other because of the following reasons:

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2. Inventions of Groups I, II and VII and III-VI and VIII-IX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, A side and B side reactants could be mixed together in a vessel before application.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group IX is not required for Groups 1-VIII, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Todd van Thomme on 5/13/2003 a provisional election was made WITH traverse to prosecute the invention of Group II, claims 38-52, 60-62 and 83-85. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-37, 53-59, 63-82 and 86-93 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 40, 44, 47-49, 62, 82 and 84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 40, 44, 48, 49, 62, 82 and 84: should be put into proper Markush terminology – selected from the group consisting of.

b) Claims 44 and 47: 2,4 diisocyanate does not appear to be a correct chemical name.

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Claim Objections

9. Claim 48 is objected to because of the following informalities: spelling errors.

Appropriate correction is required.

Information Disclosure Statement

10. Undated references in the information disclosure statements have not been considered.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 38-39, 42, 44-51 and 83-85 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 99 / 12987.

'987 teaches applying a polyurethane foam using a two part composition of an A part comprising a polyol that may be castor oil and/or other polyols such as ethylene glycol and 1,4-butanediol or mixtures thereof, or other "useful" polyols such as polyether (p9), a blowing agent such as water, a catalyst that may be a tertiary amine, and a B part that comprises (see pages 8-16) preferably a blend of two or more isocyanates, including aromatic diisocyanates such as MDI or TDI. Surfactant may also be present in either part (page 16). The two parts are meter mixed

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before use (p 16) which would necessarily mean that there was an input and output for both parts into and out of the meter mixer. Note that '987 refers to A and B parts in the opposite sense of the applicant.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 40-41, 43, 52 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99 / 12987.

'987 is applied here for the reasons given above.

'987 fails to teach soy, rape, cotton or palm oil. It would have been obvious to one of ordinary skill in the art to have substituted one of these oils for the castor oil of '987 with the expectation of similar results.

'987 fails to teach the ratio of oil to polyol, but it would have been obvious to one of ordinary skill in the art to have optimized this ratio through no more than routine experimentation.

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'987 fails to teach polyurea polyol. It would have been obvious to one of ordinary skill in the art to have substituted this polyol for one of the polyols used in '987 with the expectation of equivalent results.

Allowable Subject Matter

15. Claims 61 and 62 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not disclose nor suggest the method of claim 38 wherein the vegetable oil is reacted with an alkyl oxide such as propylene, butylene or ethylene oxides.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma C. Cameron whose telephone number is 703-308-2330.

The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


ERMA CAMERON
PRIMARY EXAMINER

Erma C. Cameron
Primary Examiner
Art Unit 1762

July 24, 2003